Appl. No. 09/663,551
Amdt. dated September 22, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 2676

PATENT

REMARKS/ARGUMENTS

The claims are not modified with this Amendment. Therefore, claims 1-19 are pending in the application. In a Final Office Action dated July 22, 2005 ("Final Office Action"), claims 1-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,384,910 to Torres in view of U.S. Pat. No. 5,977,968 to Le Blanc, and further in view of U.S. Pat. No. 5,631,974 to Lau-Kee et al ("Lau-Kee"). The Amendment submitted April 22, 2005 was objected to under 35 U.S.C. §132(a), and claims 1-19 are rejected under 35 U.S.C. §112. The rejections are respectfully traversed.

35 U.S.C. 103(a)

Missing Limitations: Claims 1, 2, 14, and 19 are the independent claims of the application. The Applicants believe a *prima facie* case of obviousness has not been properly set forth in the Final Office Action. Specifically, Lau-Kee was cited for providing a **control** accessible by a user to **reconfigure the shape** of a **subsection** of a graphical user interface ("**GUI**") *without* **supplying** an **input** to the **application** program **controlled** by the GUI and *without* **altering** the **function** of the GUI. The Applicants believe that Lau-Kee do not "teach or suggest all the claim limitations" as required. MPEP §2143.

The Final Office Action concedes that **Torres and LeBlanc fail** to **teach** this limitation (Final Office Action, p. 4, sec. 6, ¶ 2). Because the Office has specifically stated that this limitation is *not found in Torres and LeBlanc*, it necessarily follows that this limitation must be found elsewhere. The Office argues that this limitation is found in Lau-Kee, while Applicants respectfully assert that the reference contains no such limitation.

Lau-Kee comprises an apparatus and method for digital image processing which was created to allow a user to process digital images (e.g., digital photos) "relatively simply, without needing a detailed understanding of computer programming" (Lau-Kee, col. 1, ll. 63-67). Lau-Kee can hardly be considered "similar art," as suggested

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by the Office, as the present invention comprises a resizable GUI (Final Office Action, p. 4, sec. 6, ¶ 3).

The Office states that a "control" of Lau-Kee allows a user to reconfigure the shape of "display area(s) 11b or 11c or 10" (*Id.*). However, there is no teaching or suggestion in the cited portions of Lau-Kee illustrating a control to reconfigure the *shape* of the subsections (Final Office Action *cites* Lau-Kee, col. 9, ll. 34-55; col. 10, ll. 32-43, 62-67). The *shape* of the subsections ("areas") of Lau-Kee appear to be static. The content *within* the area may vary, but the cited portions of the reference do not suggest that the *shape* of the *areas* may be controlled (*See* Lau-Kee, col. 10, ll. 39).

Therefore, because the claim element at issue provides for reconfiguration of the *shape* of a subsection, and the *shape* of the areas of Lau-Kee appear static, the cited reference fails to teach the particular limitation.

Furthermore, the Office also states that reconfiguration in Lau-Kee occurs without supplying an input to the application program controlled by the GUI. The Applicants disagree. It is not in any way evident from the Final Office Action which **application controlled** by the **GUI** does not receive **input** during reconfiguration. This particular **teaching** of the claims **could not be found in** the cited portions of Lau-Kee (i.e., it appears that, in clicking the cursor over the areas, the underlying application program (the image processing application) does in fact receive input). The Final Office Action, to support the assertion that Lau-Kee teaches this limitation, merely states "e.g., without the GUI's program relying directly on the user's input to modify the display areas" (Final Office Action, p. 4, sec. 6, ¶ 3). This explanation clearly **does not illustrate** how Lau-Kee teaches the limitation at issue.

The Office Action cites swaths of the references to the particular claim limitation. In trying to understand the basis for the rejection, the particular **teaching could not be found** by the Applicant in the cited columns of the reference.

> "In rejecting claims for want of novelty or for obviousness, the ... **pertinence** of each reference, if not apparent, must be **clearly explained**" (emphasis added) 37 CFR 1.1.04(c)(2).

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The Applicants respectfully request identification of the support for the rejection related to the limitation providing reconfiguration *without* **supplying** an **input** to the **application** program **controlled** by the GUI and *without* **altering** the **function** of the GUI.

Motivation to Combine: The Applicants further believe that motivation for the specific combinations of elements in the cited references is lacking. As best understood by the Applicants, the motivation to combine arguments in the Final Office Action follow a reasoning that if someone made the combination, the advantages would be self-evident (*See, e.g.,* Final Office Action, p. 5, ll.19-22)

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01.

(1) In the Office Action, no cite is made to a reference in the art *itself* for a suggestion or motivation to combine. The Applicants, thus, assume that no such cite exists.

(2) Therefore, the Applicants assume Official Notice is being relied upon to assert that knowledge generally available in the art suggests the combination.

If this rationale is maintained, an express showing of documentary proof is hereby requested to support this stated motivation, as set forth in the documentary proof procedure described in MPEP § 2144.03. The MPEP provides that Official Notice without documentary evidence is only appropriate in "rare" cases. *Id.* Failure of the Office to provide the necessary suggestion or motivation creates the presumption that the combination of references selected were based on impermissible hindsight reconstruction. *In re* Rouffet, 149 F.3d 1350 (Fed. Cir. 1998).

Independent claims 1, 2, 14, and 19 are allowable for at least the reasons cited above. Claims 3-13 and 15-18 depend from these independent claims, and are allowable for at least the same reasons as given above. Reconsideration is respectfully requested.

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35 U.S.C. §132(a) & U.S.C. §112 rejections:

New matter rejections under 35 U.S.C. §132(a) are generally not appropriate when changes are made only to the claims of an Application. A new matter rejection should refer to changes in the Specification. The Specification is not modified in the April 22, 2005 Amendment at issue. The CCPA explained the difference between a new matter rejection and a lack of adequate written description rejections as follows:

> Broadening a claim does not add new matter to the description. ...
> The proper basis for rejection of a claim amended to recite elements
> thought to be without support ... is Section 112. *In re* Rasmussen, 650
> F.2d 1212, 211 USPQ 323, 326 (C.C.P.A. 1981).

Thus, the proper basis in law for such a rejection is §112, first paragraph, i.e. the written description requirement. This rejection is respectfully traversed. The Specification clearly imparts to one having ordinary skill in the art that a user may reconfigure the shape of the subsection without "altering the function of the GUI."

The Specification describes embodiments wherein the end-user "can reconfigure the shape of the subsection during use" (Original Application, p. 3, ll. 31-32). In various embodiments, subsections of GUI controls are allowed to be moved, expanded stretched or compressed spatially (*Id.* at p. 5, ll. 2, 8, 11-16, 22). In such embodiments, the function and layout of the subsection of the GUI may stay the same, allowing an "end-user ... to change the shape of a component of the GUI, while not changing other components of the GUI." In such embodiments, if *only* a *shape* of a component changes, it follows inherently that the function would remain the same.

The Federal Circuit has stated that the fact that the "exact words ... in question ... are not in the specification is not important" *In re* Wright, 866 F.2d 422, 9 USPQ 2d 1649, 1651 (Fed. Cir. 1989). The content of the present claims are disclosed in the Specification. One skilled in the art will clearly recognize that that the Specification discloses that a subsection of a GUI can be resized to be larger or smaller without changing its functionality.

CONCLUSION

In view of the foregoing, the Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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